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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,180	04/18/2000	Gary Greenberg	GB0002	2294

7590

05/05/2003

H Michael Brucker
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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/552,180

Applicant(s)

GREENBERG, GARY

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The present application was subjected to a restriction requirement as set forth in Paper No. 2 of 6/25/2002. In response to the restriction requirement, applicant has elected the species X with traverse. See Election (Paper No. 3) of 7/23/2002.

The restriction requirement has been made Final by the Examiner and the elected claims were examined in the Office action which a copy thereof was mailed to applicant on 10/03/2002 (Paper No. 4). In response to the Office action, applicant has filed an amendment (Paper No. 6) on 2/3/2003.

The present application is now transferred to a different examiner. A review of the pending claims, i.e., claims 1-50, in the light of applicant's arguments related to the restriction requirement, the examiner in charge of the present application at this time agrees with the applicant's opinions and thus the restriction requirement set forth in the paper No. 2 is now withdrawn. However, the pending claims 1-50 are subjected to a further restriction requirement (Note: See reasons as set forth below), and thus applicant is respectfully requested to elect one of the inventions for the purpose of examination. The present examiner sincerely apologized for any disadvantaged occurred to the applicant.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, 22-38, and 42-50, drawn to an optical system having means or dynamic aperture mask for varying the size/portion of an objective aperture, classified in class 359, subclass 738+.

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- II. Claims 20-21 (See Note 1 below), drawn to an optical system having a shaped light beam passing through a different portion of an objective aperture, classified in class 359, subclass 370+.

Note 1: It is noted that the claim 21 is drafted as a dependent claim of claim 13 (see claim 21, line 1); however, the examiner is of opinion that the claim 21 should be depend upon claim 20 because the antecedent basis for the feature "said shaped light beam" recited on line 1 of claim 21 has a support in claim 20, not claim 13. If the applicant does not have the same opinion with the examiner then the claim of group II is only claim 20, and claim 21 is regrouped into the group I.

- III. Claims 39-41, drawn to a method for creating a 3-D model of a 3-D object using a light microscope comprises the step of changing the viewing angle at each location of an object, classified in class 359, subclass 368.

3. The inventions are distinct, each from the other because of the following reasons:

A) Inventions (I and II) and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of creating a 3-D model of a 3-D object by changing the viewing angle as defined in Group III does not need to have a means for changing the portion of an objective aperture or a dynamic aperture mask located in the objective aperture as defined in the apparatus of

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Group I and/or Group II. For instance, an operator can vary/change the position of a reflecting element for the purpose of varying/changing the angle of observation.

B) Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility for varying a portion of an objective aperture without the need of using shaped light beam to different portion of the objective aperture. Applicant should note that a change in portion of an objective aperture, i. e., a change in a portion of an aperture can be understood as a change in size/dimension, and thus it does not mean a change in different portions of an aperture. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and of because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. A telephone call was made to H. Michael Brucker on 5/1/2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

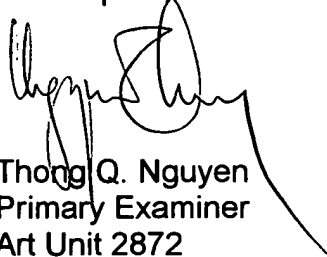
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C nclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

May 1, 2003